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09/520,763	03/08/2000	Stephen W. Comiskey	53326.000008	1661

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EXAMINER
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CHARLES, DEBRA F

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3628

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Paper No. 21

Application Number: 09/520,763  
Filing Date: March 08, 2000  
Appellant(s): COMISKEY ET AL.

\_\_\_\_\_  
Yisun Song  
For Appellant

**EXAMINER'S ANSWER**

**MAILED**

APR 26 2004

**GROUP 3600**

This is in response to the appeal brief filed March 31, 2004.

**(1) Real Party in Interest**

A statement identifying the real party in interest is contained in the brief.

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

**(3) Status of Claims**

The statement of the status of the claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Invention**

The summary of invention contained in the brief is correct.

**(6) Issues**

The appellant's statement of the issues in the brief is correct.

**(7) Grouping of Claims**

Appellant's brief includes a statement that claims 58-73 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

**(8) Claims Appealed**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) Prior Art of Record**

6,430,542	Moran	8-2002
5,918,207	McGovern et al.	6-1999

The VIP Forum, Fact Brief, Family Services, February 2000.

Upbin, Bruce. "Old Money Chasing New" Forbes, June 15, 1998, vol. 161, iss. 12.

**(10) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 58-64, 66-72 and 74-75 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moran (U.S. PAT. 6430542A), McGovern et al. (U.S. PAT. 5918207A) and The VIP Forum, Fact Brief, Family Services, February 2000 (herein The VIP Forum).

Re claim 58: Moran disclose a computer implemented method for providing personalized financial services to a client, the computer-implemented method comprising:

a depository for receiving client data from the client comprising at least one client goal and a client portfolio(col. 6, lines 5-25, 50-67, col.15, lines 40-col.16,line 25);

a server for assessing the client portfolio based at least in part on the client goal (col. 2, lines 10-25,col. 8, lines 60-67, Figs. 29-30)and

a display for providing services(col. 2, lines 60-67, Figs. 5,7A-B,10-18).

As applied to claims 58,63,66 and 71: Moran does not explicitly disclose classifying service providers in a hierarchical manner from the core service provider group, the affiliated service provider group and the non-affiliated service provider group in response to the received client data;

assigning a plurality of services to a plurality of service provider groups,

wherein whether each service is needed by the client on a frequent basis is determined or whether a level of value to the client is above a predetermined level is determined;

wherein the plurality of services are categorized into a core service provider group, an affiliated service provider group and non-affiliated service provider group based at least in part on the steps of determining wherein the steps of assessing and assigning are performed at a server.

However, in McGovern et al. (col. 2, lines 45-60) disclose automatic searches of candidates to match customer's needs and presenting the candidates in ranking order relative to the client's needs. Further, as shown by The VIP Forum (pages 6-10) the

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lead relationship manager determines the professionals the high net worth individual needs and makes these assignments and referrals. Although, it is clear the relationship manager and not the computer is making the assignments. It would have been obvious to one having ordinary skill in the art at the time the invention was made to automate the needs analysis and referral system to include ranking features based frequency of client need especially in customer relationship management systems, since it has been held that broadly providing a mechanical or automatic means to replace manual activity that has accomplished that same result involves only routine skill in the art. *In re Venner*, 120 USPQ 192.

Thus, it would have been within the level of ordinary skill in the art to modify the method of Moran by adopting the teachings of McGovern et al. and The VIP Forum to obtain a cost-efficient way of providing referrals to various professionals and specialists.

Re claims 59,62,67 and 70: Moran discloses wherein the core service provider group represents services needed by the client on a frequent basis or having a level of value above the predetermined level indicating a primary level of service;

And Moran discloses wherein the core service provider group represents services most common to the client or providing most value to the client(Abstract, col. 2, 1-60).

Re claims 60,61,68 and 69: Moran does not explicitly disclose(s) the claimed provider group represents services needed by the client on an infrequent basis and having a level of value below the predetermined level indicating a secondary level of service;

And wherein the affiliated service provider group represents services that do not fall within the core service provider group and the non-affiliated service provider group indicating an intermediary level of service.

However, in pages 6-10 thereof, The VIP Forum disclose(s) an array of services provided to clients by different parties at varying intervals as needed by the client. Thus, it would have been within the level of ordinary skill in the art to modify the method of Moran by adopting the teachings of The VIP Forum to obtain the benefit of categorizing various service providers in a hierarchical manner.

Re claims 64 and 72: Moran disclose wherein services from the core service provider group are presented to the client.

Moran does not explicitly disclose wherein services from the affiliated service provider group and services from the non-affiliated service provider group are presented after the services from the core service provider group are first presented. However, in the entire document thereof, The VIP Forum disclose(s) an array of service providers in different units of the bank or affiliated or not affiliated with the bank that are provided to high net worth individuals when their needs so dictate. Thus, it would have been within the level of ordinary skill in the art to modify the method of Moran by adopting the teachings of The VIP Forum to obtain a cost advantage in providing services and referrals to various levels of professionals when clients require to maintain a stronger, long-term client relationship.

Re claims 74 and 75: Moran disclose further comprising one or more of a tool for mining data and a synthetic logic tool for assessing the client portfolio;

And Moran disclose wherein the synthetic logic tool converts data into useful information related to the at least one client goal(Figs. All, col. 2, line 60-col. 3, line 20).

3. Claims 65 and 73 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moran, McGovern et al. and The VIP Forum as applied to claims 58 and 66 above, and further in view of Bruce Upbin, "Old Money Chasing New", Forbes, June 15, 1998, vol. 161, iss. 12 (herein "Upbin").

Re claims 65 and 73: Moran disclose wherein the services comprise a plurality of asset allocation services; investment management services; investment banking services; banking services; custody services; reporting services; tax advice services; filing of federal, state and local tax statement services; estate planning services; legal services; accounting services; bookkeeping services; record keeping services; financial investment services; managing financial assets services; management and other services related to closely held stock services; international trusts services; real estate service; development and maintenance of education funds services; business succession planning services; issuance of loans, traveler's checks, foreign currency, credit or other banking services(Abstract, Figs. All, col. 2, line 60-col. 3, line 20).

Moran does not explicitly disclose public relations services; crisis management services; selection and delivery of insurance services; physical security services; personal security services; information security services; lease, purchase or fractional



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ownership of automobiles, planes, vehicles or yachts services; personal concierge services; bill paying services; coordination and direction of charitable activities services; background checks on personal staff or other parties services; offering of investment opportunities not available to non-clients services; development and execution of debt reduction strategies services; development and maintenance of education funds services; advice and care of minors, invalids, elderly, incompetents or other persons services.

However, The VIP Fourm(entire document) discloses an array of personal financial and personal planning services typical of large family offices. Further, Upbin (entire article) describes yet more services of the multicient family office that are more personal than financial. Thus, it would have been within the level of ordinary skill in the art to modify the method of Moran by adopting the teachings of The VIP Fourm and Upbin to obtain a full-service multifamily office with full referral capabilities to locate needed professionals.

#### **(11) *Response to Argument***

1. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in

the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). Moran discloses a computer system that assists users in personal financial planning and management, McGovern et al. discloses assessing and selecting employees to meet the client's needs, and The VIP Forum discloses family offices run by banks to meet complex financial and nonfinancial needs of wealthy families. In response to applicant's argument that McGovern et al. are nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, McGovern et al. is analogous are because it is a similar solution for a similar problem and indicates in the Abstract, skill levels of employees and candidates meet the predicted technical requirements. This parallels the inventor's attempt to procure skilled professionals that are needed on a frequent or non-frequent basis depending on the level of value to the customer, that is, the predicted technical resource needs of the customer, and categorizing the employees or candidates based on skills the employees or candidates have that qualifies them to meet the resource needs predicted by the organization or the high-net worth customer as the inventor's invention indicates, in a way that ranks the employees or candidates by their value. Grouping the employees or candidates further ranks them by their value to the customer. Thus, McGovern et al. solves the same problem by effectively ranking employees by their desirability to the customer.

The applicant's ranking strategy needs to be clearly delineated in computer terms to enable the computer to clearly rank the service provider according to a specific strategy.

2. In response to applicant's argument that the examiner has combined an excessive number of references, reliance on a large number of references in a rejection does not, without more, weigh against the obviousness of the claimed invention. See *In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991).

The Attorney indicates in item B that claims 58-64,66-72 and 74-75 are improperly rejected because there is no prima facie case of obviousness as shown in Moran, McGovern et al and the VIP Forum. The VIP Forum illustrates the various services provided by a bank family office unit on page 6 where the bank relationship manager acts as a quarterback and effectively coordinates the client requests with various specialists affiliated with the bank or its subsidiaries. Thus, the bank becomes a one-stop facility for busy people with complex financial needs who pay for various services provided.

The combination of Moran, VIP Forum and McGovern et al. show how these services are ranked together with the skills of the various providers. The list of the services provided needed not be explicitly mirrored in each reference or in the combination of references to convey the same concept and solve the same problem of providing specialized services based on specific needs identified.

The Attorney indicates in item B, that claims 65 and 73 are improperly rejected via Moran, McGovern et al. and VIP Forum in addition to Bruce Upbin's article in Forbes entitled "Old Money Chasing New" which discloses nonfinancial service provision for wealthy families. Combined with Moran, McGovern et al. and the VIP Forum, which also discloses nonfinancial services provision, Bruce Upbin's article does disclose the relevant items in these claims. The list of the services provided needed not be explicitly mirrored in each reference or in the combination of references to convey the same concept and solve the same problem of providing specialized services based on specific needs identified. Thus, the prima facie case of obviousness is demonstrated.

In item C, the attorney indicates that the McGovern et al. reference is not related to providing personalized financial services to the client. The Examiner indicates the reference does disclose selecting specialized professionals based on their skills and the need for those skills. Thus, the reference solves the same problem – it is a similar solution for a similar problem. As such it meets the standards for correct use of nonanalogous art.

The Attorney further indicates the VIP Forum does not teach ranking the service providers, however, McGovern et al. teaches this in the Abstract, Abstract, col. 2, lines 1-60 thereof where it discloses the service provider analyzing the person's skills and determining if the skills are needed by the employer. This is effective ranking and

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evaluation of the specialist's skills. Determining the needs of the client is done by the VIP Forum bankers who are the relationship managers for the bank. Combining these two references yield the end result of determining when the bank client needs the service and how frequently the service is needed.

Combining the references results in a cost-efficient way of making referrals because the assessment of whether the client needs a specialist is determined by the relationship manager who has established networks of service provider contacts, and thus can make the connection for the client quickly and easily.

In item D, in response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to applicant's argument that the examiner has combined an excessive number of references, reliance on a large number of references in a rejection does not,

without more, weigh against the obviousness of the claimed invention. See *In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991).

In response to the Attorney's assertion that Moran lacks providing services in a hierarchical manner, the VIP Forum does indicate on page 7, providing services to a family based on a family's needs. These needs are inherently hierarchical. The motivation to combine the references Moran, McGovern et al. and The VIP Forum is to obtain a cost-efficient way of providing referrals to various professionals and specialists.

In item E, the Attorney indicates claim 59 is separately patentable because Moran, McGovern et al. and the VIP Forum do not disclose the core service provider group represents services needed by the client on a frequent basis or having a level of value above the predetermined level indicating a primary level of service. The VIP Forum does indicate the banker is the core service provider group and coordinates providing services for the client based on need, pages 6,7,11,17,18 and 22. Thus, there is a teaching and motivation to modify Moran, McGovern et al. and The VIP Forum.

The attorney also indicates relevant to claims 60,61, 62, 63, 64,67,68,69,70,71,72,74, and 75 that Moran, McGovern et al. and The VIP Forum does not disclose the items

mentioned in the claims. The examiner has indicated above that the items in the claims are represented in the references as explained under the 103 rejection above.

In item F, the Attorney indicates that claims 65 and 73 are rejected over Moran, McGovern et al. and The VIP Forum in view of Bruce Upbin's "Old Money Chasing New" fail to address the deficiencies of Moran, McGovern et al. and The VIP Forum.

The Examiner indicates The VIP Fourm(entire document) discloses an array of personal financial and personal planning services typical of large family offices. Further, Upbin (entire article) describes yet more services of the multiclient family office that are more personal than financial. Thus, it would have been within the level of ordinary skill in the art to modify the method of Moran by adopting the teachings of The VIP Forum and Upbin to obtain a full-service multifamily office with full referral capabilities to locate needed professionals.

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,

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Examiner  
Art Unit 3628

DFC  
April 15, 2004

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